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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,412	07/30/2001	Bin Lu	ENR-015	4205

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EXAMINER

PRIETO, BEATRIZ

ART UNIT PAPER NUMBER

2142

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/919,412

Applicant(s)

LU ET AL.

Examiner

Prieto Beatriz

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/30/01.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This communication is in response to Application No. 09/919,412 filed 07/30/01, claims 1-43 were examined.

***Claim Rejection under 35 U.S.C. 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-9, 13-21, 23-24, 28-36, 38, 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,771,355 Kuzma.

Regarding claim 1, Kuzma teaches a system substantially features of the invention as disclosed, including: a system and method (Figs. 1-3 and col 1/lines 26-56, method col 14/lines 24-43) configured to access a media file, comprising:

a sender client configured to provide a message comprising a recipient address and a handle to a media file (col 1/lines 13-22, col 2/lines 24-58, reference col 1/lines 36-67, pointer location col 5/lines 10-54);

a server configured to receive and provide said message from the sender client to a receiver client that corresponds with said recipient addresses, said receiver client configured to receive said message from said server (col 3/lines 26-62);

wherein said receiver client is configured to access said media file from a source selected from the sender client and a peer receiver client/server source of the media file (col 44/lines 44-47, col 5/lines 10-54 and col 6/lines 8-15).

Regarding claims 2-3, wherein the sender and receiver clients are a personal computer (120 of Figs. 1-2, col 3/lines 7-18).

Regarding claim 4, wherein the server is an application service provider accessed via an Internet (301)(col 3/lines 19-46, col 3/line 63-col 4/line 10).

Regarding claim 5, wherein said message comprises a text of data information (col 1/lines 23-25).

Regarding claim 6, address are network email address (col 1/lines 14-22)

***Claim Rejection under 35 U.S.C. 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 22, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma in view of U.S. 6,295,058 HSU, et. al. (Hsu hereafter).

Regarding claim 7,

Hsu teachings pertaining the invention's field of endeavor, discusses as prior art the transmission of electronic mail containing audio and/or visual files obtained from various sources, e.g. a video cassette recorder or camcorder are converted in a suitable format, e.g. MPEG and stored locally on a storage device, and transmitting stored files as an email to a mail server (col 2/lines 3-15);

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma that the personal computers may be any suitable computer system which additionally may include a special purpose video processor, a video camera, and graphic viewer programs for rendering graphic files associated with email messages. One ordinary skilled in the art would be motivate create multimedia emails with a simple for of electronic communication to enable accessible to the general public and using an open architecture providing a service independent of the email service provider, as taught by Hsu.

Regarding claims 8-9, the sender and receiver client is further configured to use an HTTP protocol to provide and receive the location message (Kuzma: col 3/lines 63-col 4/line 31, 44-50).

6. Claims 10-12, 25-27 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma in view of U.S. 6,457,879 THURLOW, et. al. (Thurlow hereafter)

Regarding claims 10-12, 25-27 and 39-41, however Kuzma does not explicitly teach a connection determination step.

Thurlow teaching pertaining to the invention's field of endeavor, teach determining the connection status between a client and server (col 15/lines 47-57, col 16/lines 54-67), and processing messages according to determined connection status (abstract).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma for enabling clients to have server functions to enable any client access each other in a peer fashion to include Thurlow's teachings for processing messages, e.g. sending and receiving between clients via servers. The teachings of Thurlow when applied to Kuzma will enable the clients or server to perform connection status determinations and process messages according to determined status. One would be motivated to provide users poll email server or client, e.g. recipients while online for incoming messages or reception availability, respectively, or offer user the option to work online or offline, discussed by Thurlow.

Regarding claims 13-15, connections between sender, mail server and recipient are Internet protocol based supported (Kuzma: col 12/lines 33-49). The system of claim 1, further comprising:

Regarding claim 16, this claim is substantially the same a claim 1, wherein "configured" has been changed for "coupled", same rationale of rejection is applicable.

Regarding claims 17-22, these claims are substantially the same as claims 2-7, discussed above same rationale of rejection is applicable.

Regarding claim 23, the protocol used by the receiver client to provide the location message is HTTP (Kuzma: col 12/lines 33-49).

Regarding claim 24-30, these claims are substantially the same as claims 9-15, same rationale of rejection is applicable.

Regarding claim 31, this claim comprises in substance the same subject matter discussed on claim 1, same rationale of rejection is applicable.

Regarding claims 32-43, these claims are substantially the same as claims 2-15, same rationale of rejection is applicable.

**Pertinent Prior Art:**

7. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure; pertinence is presented in accordance with MPEP§ 707.05. Copies of Non-Patent Literature documents cited are provided as set forth in MPEP§ 707.05(a):

**US 5,802,314 (09-1998) Method and apparatus for sending and receiving multimedia messages**

Tullis, et. al. teach a method/apparatus for creating and processing messages whose parts include differing types of information, i.e. multimedia in a single message, e.g. voice, image, text, etc. , as well as link information a "handle" to data in other application programs ("object linking and embedding" links or "OLE" links). The method/apparatus capable of sending and receiving multimedia messages by any one of a variety of transmission devices such as facsimile, voice telephone, and e-mail.

**US 5,855,020 (12-1998) Web scan process**

Kirsh teaches a system/method for receiving electronic messages over the Internet and processing said messages for identifying and extracting handles to media files, i.e. embedded URLs

**US 5,860,068 (Jan. 1998) Method and system for custom manufacture and delivery of a data product**

Cook teaches a system/method for generating an email and embedding therein a hyperlink "handle" to a media file, e.g. a web site.

**US 5,903,723 (May 1999) Method/apparatus for transmitting e-mail attachments with attachment references**

Beck et. al. teaches a method of operation of e-mail system 600 (Fig. 6), wherein a sender 612 then supplies any message 626 and a handle "URL pointer 627 in HTML page". The message and URL hypertext link are added to the recipient's mail page. When and if recipient 622 decides to read the attachment 611, for example by clicking on a hypertext link embedded in message 626, where the "handle" hypertext link incorporates URL 627, attachment 611 is retrieved by recipient 622, using its server 620, URL 627, and Internet 601.

**US 5,960,403 (Sept. 1999) Health management process control system**

Brown teaches a computer configured with a message or electronic mail program configured for embedding a pointer to a program file in the message, the pointer is user selectable and executable connecting the user to the said program file.

**US 5,978,836 (Nov. 1999) Workflow systems and methods**

Ouchi teaches the integration of e-mail and WWW technologies, wherein e-mails include handles to media file, e.g. a URL address of an Internet site or a specific web page or IP, the system address of an Internet site. Many e-mail systems are integrated with web browser technology, thereby enabled to launch a connection to a web site from a URL or IP address embedded in e-mails or connect to sites by selecting the address embedded in the e-mail.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

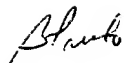
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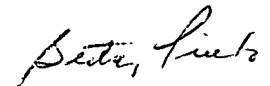
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Or Telephone:

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B. Prieto  
TC 2100  
Patent Examiner  
January 27, 2005

  
Patent Examiner